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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/773,589	02/06/2004	Nokihisa Adachi	428291/0024	8964

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EXAMINER

NGUYEN, PHONG H

ART UNIT	PAPER NUMBER
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3724

DATE MAILED: 02/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/773,589	Applicant(s) ADACHI ET AL. ED	
	Examiner Phong H Nguyen	Art Unit 3724	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Information Disclosure Statement

1. The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
3. Claims 1-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term "and/or" is confusing. It is unclear what limitation is included or is not included. All claims are interpreted as best understood by the Examiner.

Claim 1 recites the limitation "the surface of said paperboard" in lines 5 and 6. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1, 2 and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by Applicant's admitted prior art, hereinafter AAPR.

Regarding claim 1, AAPR teaches method for controlling a slitter-scorer apparatus including the steps of supplying a paperboard sheet along a feed line, and moving a slitter or a scorer in a vertical and/or a widthwise direction to an operative level where the surface of the paperboard sheet processed thereby wherein:

movement of said slitter and/or scorer is controlled such that the slitter and/or scorer either comes into sliding contact with or is apart slightly from the surface of the paperboard sheet.

See page 1, line 10-page 3, line 7 of the Specification.

Regarding claim 2, AAPA anticipates the claimed distance between the slitter and the paperboard since the term "about 10 mm" is interpreted as slightly greater or slightly smaller 10 mm, which is within the claimed range.

Regarding claim 7, a slitter and an anvil cut off a paperboard. See line 10-page 3, line 7 of the Specification.

6. Claim 8 is rejected under 35 U.S.C. 102(b) as being anticipated by Aoki (US Pub. 2001/0002560 A1).

Aoki teaches method for controlling a slitter-scorer apparatus including the steps of supplying paperboard sheet along a feed line, and moving a slitter or a scorer in a vertical and/or a widthwise direction between an operative level thereof where the paperboard sheet is processed and retracted level where jam-up of the paperboard sheet avoided, further including the step of:

positioning said slitter and/or scorer in a standby position which more proximal to the surface of the paperboard than said retracted level, while said slitter and/or scorer does not work upon the surface the paperboard. See Fig. 1 and paragraphs 33 and 34.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 3-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over AAPA in view of Shinomiya et al. (4,506,577), hereinafter Shinomiya.

Regarding claim 3, AAPA teaches the invention substantially as claimed except for the step of moving a slitter simultaneously in a vertical direction and horizontal direction. Shinomiya teaches the step of moving a slitter simultaneously in a vertical direction and horizontal direction. See page 3, lines 5-25. It would have been obvious to one skilled in the art to program the slitter so that it would be moved simultaneously in a vertical direction and horizontal direction in order to reduce set up time.

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Regarding claim 4, in order the change to be cut width of a paperboard, at least one slitter of a slitter assembly has to move to a second position. In other words, while one slitter moves to a second position, the other slitter is in the paperboard.

Regarding claims 5 and 6, the movement path of the slitter would be in form of a plurality of straight lines or a curve depending upon the linear velocity in the vertical direction and the horizontal direction.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Koskela (3,540,340), Gunn et al. (3,886,833), Shainberg et al. (3,961,547), Anderson et al. (4,627,214), Miller et al. (5,125,301) and Tokuno et al. (4,684,360) teach slitter of general interest.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Phong H Nguyen whose telephone number is 571-272-4510. The examiner can normally be reached on Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allan Shoap can be reached on 571-272-4514. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status

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information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

PN:

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February 8, 2005

AS

Allan N. Shoap
Supervisory Patent Examiner
Group 3700